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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/808,031	03/03/1997	SUMIKO INOUE	377.5888P	5819

35811 7590 02/24/2006

IP GROUP OF DLA PIPER RUDNICK GRAY CARY US LLP
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EXAMINER

HUTSON, RICHARD G

ART UNIT PAPER NUMBER

1652

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/808,031

Applicant(s)

INOUE ET AL.

Examiner

Richard G. Hutson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's amendment of figure 14 of the specification, in the paper of 11/25/2005, is acknowledged. Claims 5 and 7 are still at issue and are present for examination.

Applicants' arguments filed on 11/25/2005 have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Upon further consideration, the following rejections are made. Any inconvenience to applicants is apologized for.

Specification

The disclosure is objected to because of the following informalities:

Applicants description of figure 14 which recites the sequence identifiers associated with the sequences listed in the figure are objected to because they are not in agreement with the listed sequences. For example SEQ ID NO: 32 which is stated to correspond to Mx65 does not match the sequence listed in the figure. For instance at position 171 of SEQ ID NO: 32, there is a "Leu", while the corresponding position of Fig 14 lists a "Y" or Tyrosine. Additionally at positions 171-173 of SEQ ID NO: 34, there is a "Tyr Gly Tyr", while the corresponding position of Fig 14 lists a "LGF". Applicant's attention is not only directed to these specifically cited sequence conflicts, but to any other additional sequence conflicts that exist in the application.

Additionally applicants Figure 14 lists a "consensus" sequence of amino acids that does not appear to have a corresponding sequence identifier (i.e. SEQ ID NO).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 (claim 5 dependent on) is indefinite in that the recitation "Tyr-Xaa6-Asp-Asp of SEQ ID NO.: 50, wherein Xaa6 is alanine or cysteine, wherein said sequence is located in subdomain 5 shown in Fig14. at positions 175-191 of SEQ ID NO: 32...and at positions 157-173 of SEQ ID NO: 38" as it is unclear exactly what applicants are claiming in reciting such a recitation. It is unclear if it is applicants intent that the claimed genus of bacterial reverse transcriptases comprises the positions indicated in the above recitations or is it applicants intent that they merely provide a basis for the additionally recited SEQ ID NO: 50. See also above objection to the specification as well as the rejection under 112 first paragraph.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 7 are directed to all possible bacterial reverse transcriptases with the specified amino acid positions (See also above 112 second paragraph). The specification, however, only provides the representative species of SEQ ID NOS: 32-38, encompassed by this claim. There is no disclosure of any particular structure to function/activity relationship in the single disclosed species. The specification also fails to describe additional representative species of these enzymes by any identifying structural characteristics or properties other than the activities recited in claims 7, for which no predictability of structure is apparent. Given this lack of additional representative species as encompassed by the claims, Applicants have failed to sufficiently describe the claimed invention, in such full, clear, concise, and exact terms that a skilled artisan would recognize Applicants were in possession of the claimed invention.

Applicant is referred to the revised guidelines concerning compliance with the written description requirement of U.S.C. 112, first paragraph, published in the Official Gazette and also available at www.uspto.gov.

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Claims 5 and 7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 5 and 7 are additionally rejected under this statute because the recitation "Tyr-Xaa6-Asp-Asp of SEQ ID NO.: 50, wherein Xaa6 is alanine or cysteine, wherein said sequence is located in subdomain 5 shown in Fig14. at positions 175-191 of SEQ ID NO: 32...and at positions 157-173 of SEQ ID NO: 38" is not supported by the specification at the time of filing and is thus considered new matter. See also above 112 second paragraph rejection.

Applicant is referred to the revised guidelines concerning compliance with the written description requirement of U.S.C. 112, first paragraph, published in the Official Gazette and also available at www.uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G. Hutson whose telephone number is (571) 272-0930. The examiner can normally be reached on 7:30 am to 4:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (571) 272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Richard G. Hutson', with a long horizontal stroke extending to the right.

Richard G Hutson, Ph.D.
Primary Examiner
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2/16/2006